

Appln. No.: 09/993,513  
Amendment dated October 27, 2005  
Reply to Office Action of May 19, 2005

### REMARKS/ARGUMENTS

The Office Action of May 19, 2005, has been carefully reviewed and these remarks are responsive thereto. Reconsideration and allowance of the instant application are respectfully requested.

#### *Rejections Under 35 U.S.C. § 103*

Claims 1-4, 6, 8, 9, 11-19, 21, 23, 24, 26-33, 35, 37, 38, 40, and 41 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Schroeder *et al.* (U.S. Pat. No. 6,405,060, hereinafter Schroeder) in view of Jones (U.S. Pat. No. 5,258,748). Claims 7, 10, 22, 25, 36, and 39 also stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Schroeder in view of Jones. These rejections are respectfully traversed.

In order to establish a *prima facie* case of obviousness under § 103(a), three criteria must exist: 1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings; 2) there must be a reasonable expectation of success; and 3) the prior art reference(s) must teach or suggest all the claim limitations. *See* MPEP § 706.02 (j); *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991).

However, even if combined, the alleged combination would not teach or suggest all the features of any claim. For example, claim 1 recites "the user ... selects the first candidate word in the text string by pressing a select-key for a period shorter than a predetermined period of time, and the entire text string by pressing the select-key for a period longer than a predetermined period of time." The Office Action alleges that Jones teaches such a feature at col. 3, line 25 – col. 4, line 13. However, such is not the case.

While Jones does describe a calculator that has a multi-function key that has multiple functions associated with the key, Jones does not teach or suggest inputting a word if the key is pressed for a period shorter than a predetermined time, and inputting an entire text string if the key is pressed for a period longer than the predetermined period of time, as claimed. Instead, in Jones, when the multi-function key is pressed for only a nominal time, the calculator performs the key's associated function (e.g., sin, cos, etc., as found on a calculator). When the multi-

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function key is pressed for more than a nominal time, the calculator displays a group of menu labels associated with the key. Nowhere does Jones teach or suggest that the key's function is to input a word or a text string comprised of multiple words, nor that displaying a group of menu labels is equivalent to inputting an entire text string. Schroeder likewise fails to teach or suggest such a feature.

Thus, even if Schroeder were modified with Jones, the modified system might perform a key's function when the key was pressed for only a nominal time, but the modified system would display a subsequent menu associated with the key when the key was pressed for more than a nominal amount of time; the modified system would not input a text string comprised of multiple words. Such a teaching or suggestion is found only in applicant's own disclosure, the use of which would be improper in formulating a rejection. Applicants therefore respectfully submit the rejection is improper, and request that it be withdrawn.

In addition, with respect to claim 2, Schroeder does not teach or suggest that the candidates in the word completion dictionary comprise a plurality of text strings each consisting of a plurality of words. Instead, Schroeder at col. 5, lines 46-55 describes a list of words entered by the user, which are used to build a character frequency table. Schroeder does not indicate that a single entry may include multiple words, nor that the words are even used as entries in a word completion dictionary.

In addition, with respect to claim 3, Schroeder describes picking words letter by letter, not word by word, as is clearly shown in Fig. 3 of Schroeder.

Claims 4 and 6-13 are also allowable based on the allowability of their respective base claims.

Independent claim 14 recites similar allowable features as those discussed with respect to claim 1, above. Independent claims 14 and 28 and dependent claims 15-19, 21-27, 29-33, and 35-41 are therefore allowable for similar reasons as already discussed.

### CONCLUSION

All rejections having been addressed, Applicant respectfully submits that the instant application is in condition for allowance, and respectfully solicits prompt notification of the

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same. However, if for any reason the Examiner believes the application is not in condition for allowance or there are any questions, the Examiner is requested to contact the undersigned at (202) 824-3153.

Respectfully submitted,  
BANNER & WITCOFF, LTD.

Dated this 27 day of October, 2005

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